

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on November 4, 2004, the Examiner rejected claims 1, 2, and 4-28, under 35 U.S.C. 103(a) as being unpatentable over Kondo (JP 200095663A) in view of Gidlund (U.S. Pat No. 6,436,449), and Duffy et al. (U.S. Pat. No. 5,472,699). Accordingly, Applicant respectfully provides the following:

Rejections under 35 U.S.C. 103

The combined references fail to teach each element of the claimed invention. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991). Claim 1 of the present invention claims a “skin toner...comprising...processed *Morinda citrifolia* juice and oil extract with at least one ingredient selected from a balancing toner ingredient and hydrating toner ingredient ...” Examiner indicates that Kondo teaches using noni extracts in a cosmetic composition but fails to teach processed *Morinda citrifolia* juice and oil extract. Examiner indicates that Gidlund teaches extracts from juice, and that Duffy teaches specific additive components for botanical astringents. The references cited by the Examiner, alone or in combination fail to teach the limitations of the present invention. Applicant respectfully submits that 1) extracts are not juice and oil extracts combined; 2) methods for treating tinnitus are not methods for making and administer a topical cosmetic skin toner; and 3) Kondo teaches away from the present invention.

Kondo teaches compositions containing bark extracts and Gidlund teaches using extracts from roots, bark, leaves and fruit. The present invention claims a method of applying juice combined with oil extract to the skin. Bark is not fruit, and isolating one extract from the fruit and ingesting it to ameliorate tinnitus, as taught in Gidlund, would not produce the desired effect of the claim method of the present application.

Examiner indicates that Gidlund teaches that extracts from different parts of the plant can be indistinguishably used, and that consequently one of ordinary skill in the art would recognize that different ingredients perform the same function. Gidlund's "invention is based on the discovery that an extract from *Morinda citrifolia* L" provides substantial relief for tinnitus sufferers. Gidlund, col 3 lns. 60-63 (emphasis added). Gidlund later notes that "[t]he extract from *Morinda citrifolia* L. may be derived from the root, the bark, the leaves or the, fruits..." Gidlund, col. 4 lns. 19-23 (emphasis added). Accordingly, Gidlund teaches that a particular extract useful for treating tinnitus may be extracted from the roots, bark, leaves and fruit, not that all extracts may be extracted from any part of the *Morinda citrifolia* plant.

Different parts of the plant do not have the same effects. Humans can consume and digest fruit but humans cannot consume and digest bark. Small molecular changes in polysaccharides result in dramatic biological differences. Bark consists primarily of cellulose while the fruit consists mainly of starch. As a consequence of a small molecular difference between starch and cellulose, the fruit but not the bark is digestable by humans. Bark and fruit for the purposes of human applications are essentially different.

Different parts of the *Morinda citrifolia* plant have different chemical structures. Thus, it cannot be said that the ingredients in the bark would inherently provide the same effects as the ingredients form the fruit, because these ingredients are distinctly different. For example, the leaves of *Morinda citrifolia* contain: alanine, anthraquinones, arginine, ascorbic acid, aspartic acid, calcium, beta-carotene, cysteine, cystine, glycine, glutamic acid, glycosides, histidine, iron, leucine, isoleucine, methionine, niacin, phenylalanine, phosphorus, proline, resins, riboflavin, serine, beta-sitosterol, thiamine, threonine, tryptophan, tyrosine, ursolic acid, and valine. The fruit of *Morinda citrifolia* contains: acetic acid, asperuloside, butanoic acid, benzoic acid, benzyl

alcohol, 1-butanol, caprylic acid, decanoic acid, (E)-6-dodeceno-gamma-lactone, (Z,Z,Z)-8,11,14-eicosatrienoic acid, elaidic acid, ethyl decanoate, ethyl hexanoate, ethyl octanoate, ethyl palmitate, (Z)-6-(ethylthiomethyl) benzene, eugenol, glucose, heptanoic acid, 2-heptanone, hexanal, hexanamide, hexanedioic acid, hexanoic acid (hexoic acid), 1-hexanol, 3-hydroxy-2-butanone, lauric acid, limonene, linoleic acid, 2-methylbutanoic acid, 3-methyl-2-buten-1-ol, 3-methyl-3-buten-1-ol, methyl decanoate, methyl elaidate, methyl hexanoate, methyl 3-methylthiopropanoate, methyl octanoate, methyl oleate, methyl palmitate, 2-methylpropanoic acid, 3-methylthiopropanoic acid, myristic acid, nonanoic acid, octanoic acid (octoic acid), oleic acid, palmitic acid, potassium, scopoletin, undecanoic acid, (Z,Z)-2,5-undecadien-1-ol, and vomifol. The roots of *Morinda citrifolia* contain: anthraquinones, asperuloside (rubichloric acid), damnacanthal, glycosides, morindadiol, morindine, morindone, mucilaginous matter, nor-damnacanthal, rubiadin, rubiadin monomethyl ether, resins, soranjidiol, sterols, and trihydroxymethyl anthraquinone-monomethyl ether. The root bark of *Morinda citrifolia* contains: alizarin, chlororubin, glycosides (pentose, hexose), morindadiol, morindanigrine, morindine, morindone, resinous matter, rubiadin monomethyl ether, and soranjidiol. The wood of *Morinda citrifolia* contains: anthragallol-2,3-dimethylether; from the tissue culture: damnacanthal, lucidin, lucidin-3-primeveroside, and morindone-6beta-primeveroside. The plant *Morinda citrifolia* contains: alizarin, alizarin-alpha-methyl ether, anthraquinones, asperuloside, hexanoic acid, morindadiol, morindone, morindogenin, octanoic acid, and ursolic acid. See *Specification* pg. 21-22.

Methods for treating tinnitus are not methods for making and administer a topical cosmetic skin toner. The present invention claims a method for making and administering a topical cosmetic skin toner, not a method of treating tinnitus. Even if every part of *Morinda*

citrifolia was interchangeable for use with tinnitus that does not mean that all parts of *Morinda citrifolia* are interchangeable for use in a toner. A chemical constituent present in all parts of the *Morinda citrifolia* plant may successfully ameliorate tinnitus, but the chemical constituent found in the processed *Morinda citrifolia* juice of the present invention may not be found in the bark, leaves or roots. If all of the parts were interchangeable then one would derive the same benefit by rubbing wood from the *Morinda citrifolia* tree on their face instead of applying the juice as claimed by the present invention. Extracts from the wood and leave may work to ameliorate tinnitus as taught by Gidlund, but rubbing wood on your face is not the same as rubbing juice on your face.

Applicant respectfully submits that Kondo teaches away from the presently claimed invention. A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. In re Geisler, 116 F.3d 1465, 1471 (Fed. Cir. 1997). In the Office Action the Examiner indicates that Kondo teaches cosmetic composition comprising plant extracts, including *Morinda citrifolia*, which provide skin whitening, oxygen scavenging and/or antimicrobial effect. *Morinda citrifolia* is disclosed by Kondo, but Kondo teaches away from using *Morinda citrifolia* alone. In paragraph 4 Kondo indicates, speaking of *Morinda citrifolia* and other vegetable extracts generally, that they have a low antibacterial effect, and that the benefit of the Kondo invention includes improved antibacterial effect. Consequently, Kondo is teaching away from the present invention in which *Morinda citrifolia* is utilized independent of other ingredients added to facial treatments disclosed in Kondo.

Applicant respectfully submits that because fruit and bark are distinctive, the example formulation taught in Kondo utilizing ingredients from bark cannot be said to teach the same

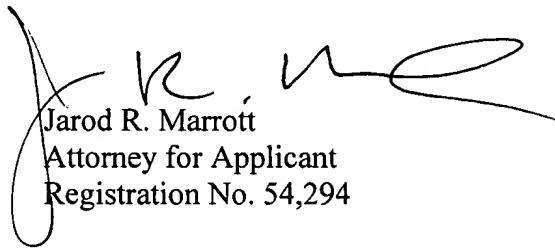
effects as a similar formulation utilizing ingredients from the fruit. Gidlund cannot be relied on to teach the use of processed *Morinda citrifolia* fruit juice, because Gidlund teaches extracts not the fruit juice of the present invention. Gidlund does not teach composition utilized in the present application. Because Gidlund teaches a method of treating tinnitus its teachings do not teach utilizing any of the compositions disclosed a method of apply a topical cosmetic skin toner. Finally, none of the references cited fairly teach or suggest combining *Morinda citrifolia* fruit juice and oil extract into a toner. Accordingly, Applicant respectfully submits that for at least the reasons provided herein, the references cited by the Examiner, alone or in combination, do not teach or suggest all the claim limitations. Consequently, Applicant respectfully submits that for at least the reasons provided herein, that claims 1, 2, and 4-28 as provided herein are novel and non-obvious.

CONCLUSION

Applicants submit that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

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Respectfully submitted,



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